REMARKS

Reconsideration of this application, in view of the amendment, is respectfully requested.

Claims 4 and 6 have been amended for the better readability thereof in conformity with the claim language previously deemed acceptable by the Examiner in the parent case issued under U.S. Patent No. 6,358,980 B1. As a consequence, Applicants respectfully request that the rejection of Claim 4 under 35 U.S.C. § 112, first and second paragraphs, and the rejection of Claim 6 under 35 U.S.C. § 112, first paragraph, be withdrawn.

The Examiner has rejected Claims 1, 2 and 4-6 under the Judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1-5 of U.S. Patent No. 6,340,691 for reasons stated on page 3 of the Office action. Applicants respectfully traverse the rejection.

The present unique alkynyloxy derivatives are neither claimed nor covered in the '691 patent. Since the physical, chemical and biological characteristics of the present compounds cannot be predicted from the prior compounds without undue experimentation, they cannot be considered an obvious variation of the patented compounds. The chemist will not be motivated to modify the patented compounds without a hint of predictability.

Despite the cases cited by the Examiner to the contrary (for instance, *Ex parte Nathan & Hogg*, 121 U.S.P.Q. 349 (POBA 1956)), it has been well established that slight structural differences can justify separate patents. For example, the Board of Appeals reversed the rejection of compounds having an alkylene group between a ring and ester function of prior art compounds (*Ex parte Biel*, 124 U.S.P.Q. 109 (POBA 1958); *Ex parte Goonewardene et al.*, 160 U.S.P.Q. 288 (POBA 1968)). Similarly, the insertion of a CH_2 group between the CO and COOH of a -CO COOH group of a prior art compound was held to be sufficient structural difference to render the claimed compounds patentable, even in the absence of a showing of unexpected properties (*Ex parte Burtner et al.*, 89 U.S.P.Q. 547 (POBA 1950)).

In the present case, it is clear that the instant claims are not a *prima facie* obvious variation of the patented claims. Applicants respectfully ask, therefore, that this double-patenting rejection be withdrawn and the application be allowed to issue as a patent.

ANNE M. ROSENBLUM ATTORNEY AT LAW
163 DELAWARE AVENUE - SUITE 212 • DELMAR, NEW YORK 12054 • TELEPHONE: (518) 475-0611